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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/764,688 | 01/16/2001 | Mary Ann Fitzmaurice | 40655.0100 | 6906 |

7590 12/06/2001

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EXAMINER

LE, UYEN CHAU N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2876

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/764,688 | FITZMAURICE ET AL. | |
| | Examiner | Art Unit | |
| | Uyen-Chau N. Le | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities:

Re claim 8, line 2: Substitute "membership0" with -- membership --.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackenthun (US 5,969,318) in view of Brake, Jr. et al (US 6,032,136).

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Re claims 1-19, Mackenthun discloses a method of providing a multiple-service card. The method comprises the steps of receiving an application for a multiple-service card from a consumer 10; communicating/transmitting the credit card information to a provider of credit services [40A-40I]; causing a multiple-service card to be sent to the consumer by the card manufacturing apparatus [22, 23]. Request a card administrator 30; the card administrator 30 communicating with a card service engine [40A-40I]; the card service engine [40A-40I] communicating with card generator [22, 23]; the card generator [22, 23] communicating with the card administrator 30; the administrator 30 communicating with the consumer 10 for confirmation (figs. 1-6; col. 4, line 30 through col. 10, line 54).

Mackenthun fails to teach or fairly suggest the steps of authorizing the credit card information; and the communicating to the service partner; and that the multiple-service card is configured for providing a primary party's services and a service partner's services.

Brake Jr. et al teaches the above limitation by verifying the customer's information before adding a secondary service to the primary service 25 and both primary feature/indicia 72 and secondary feature/indicia 74 present on the multiple-service card (figs. 1-3; col. 4, line 58 through col. 6, line 26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Brake Jr. et al into the teachings of Mackenthun in order to provide Mackenthun with a universal system, wherein the card can be used in multiple applications due to its multiple-services (e.g., primary service, secondary service, and other additional services, etc. (Brake Jr. et al: col. 5, lines 30-40)). Furthermore, such modification would provide Mackenthun with a more secure system, wherein the customer's identity can be verified via authorizing step, preventing

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fraudulent user of the card. Accordingly, such modification would have been an obvious extension as taught by Mackenthun, well within the ordinary skill in the art, and therefore an obvious expedient.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Mackenthun (WO 99/27492); Sehr (US 6,085,976); Maes et al (US 6,016,476); and Mandelbaum et al (US 5,544,246) are cited as of interest and illustrate a similar structure to a multiple-service card system.

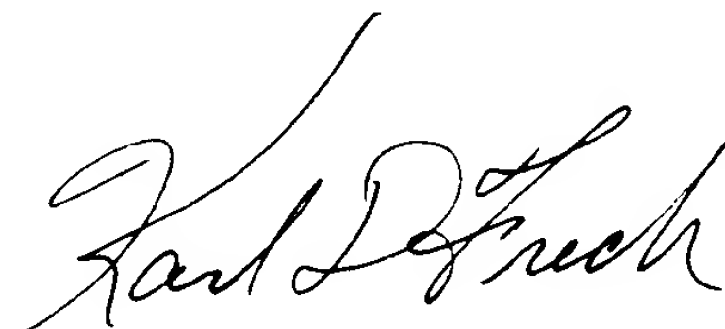
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-T and TR-F 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Uyen-Chau N. Le

December 2, 2001



KARL D. FRECH
PRIMARY EXAMINER